

REMARKS

I. Introduction

In response to the Office Action dated June 19, 2006, Applicant has amended claims 22 and 35 so as to further clarify the claimed invention. No new matter has been added.

For the reasons set forth below, Applicant respectfully submits that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 22-31 Under 35 U.S.C. § 102

Claims 22-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by USP No. 6,226,890 to Boroson. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 22, as amended, recites in-part an inert material disposed in the encapsulated device, where the inert material is adapted to respond to energy input by melting.

In the statement of rejection, the Examiner reads the binder 52 contained in the desiccant layer 50 of Boroson as the claimed inert material, and asserts that Boroson teaches, at col. 4, lines 45-49, that "the binder 52 is radiation-curable and undergoes morphological changes from liquid to solid when exposed to thermal energy" (page 7, 2nd paragraph of Office Action). Although Applicant does not agree, in an effort to advance prosecution, Applicant has deleted the term "morphological change" from claim 22, rendering the Examiner's argument with respect to claim 22 moot.

Boroson expressly teaches away from the claimed invention, in that Boroson teaches heating and curing the desiccant layer 50 including the binder 52 to a solid under controlled conditions so as to remove residual solvents (see, col. 6, lines 59-62). That is, the desiccant layer 50 of Boroson is cured by heating, and therefore is not adapted to respond to energy input by melting, as recited in claim 22.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Boroson fails to teach the foregoing claimed features, Applicant

respectfully submit that Boroson does not anticipate claim 22 or any of the claims dependent thereon.

III. The Rejection Of Claims 35-36 and 38 Under 35 U.S.C. § 102

Claims 35-36 and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by USP No. 6,737,176 to Otsuki. Applicant respectfully traverses this rejection for at least the following reasons.

Claim 35, as amended, recites in-part, a first layer of a reactive material, and a second layer of an inert material disposed on the first layer, the inert material adapted to respond to energy input by melting.

Otsuki describes an organic electroluminescent (EL) device (Fig. 3). The EL device includes an EL stacked structure 22 having an organic luminescent layer 18 and a hole transport layer 16 sandwiched between an anode 12 and a cathode 20 (col. 2, lines 57-61). The stacked structure 22 is sealed between a transparent substrate 10 and a sealing can 24 (col. 2, lines 61-62). The organic EL device 100 has a desiccant-containing layer 62 formed on the inner surface 68 of the sealing can 24 (col. 6, lines 1-10). The desiccant-containing layer includes a desiccant layer and resin layer formed in a layered structure, and may be mixed with and dispersed in resin (col. 4, lines 9-14). The resin is a photo-curable resin (col. 4, lines 14-46).

The Examiner asserts that the resin layer in the desiccating layer 62 of Otsuki can be adapted to respond to energy by morphological change (e.g., cured by heating or exposure to light) (page 8, lines 1-5 of Office Action). Although Applicant does not agree, in an effort to advance prosecution, Applicant has deleted the term "morphological change" from claim 35, rendering the Examiner's argument with respect to claim 35 moot.

Further, as recognized by the Examiner, Otsuki expressly discloses that the resin layer is a photo-curable resin (i.e., cured by heating, col. 6, lines 33-35). That is, the resin layer of Otsuki is cured by energy input, and is not adapted to respond to energy input by melting.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Otsuki fails to teach the foregoing claimed feature, Applicant

respectfully submits that Otsuki does not anticipate claim 35 or any of the claims dependent thereon.

Case Law: In Re Hutchison

In the "Response to Argument" section, with respect to the rejection of claim 22, the Examiner argues, in reliance upon *In re Hutchison*, that the recitation that the inert material is "adapted to" respond to energy input by melting "is not a positive limitation but only requires the ability to so perform" (page 7, 4th paragraph of Office Action).

The Examiner's reliance on case law is misplaced.

First, even under the standard set forth by the Examiner, the limitation is entitled to patentable weight. As currently claimed, the inert material adapted to respond to energy input by melting. Under the Examiner's standard, the phrase "adapted" "requires the ability to so perform". Thus, the claim requires the inert material to have the ability to respond to energy input by melting. Since Boroson and Otsuki teach materials that are cured in response to energy, Boroson and Otsuki fail to disclose material that has the ability to respond to energy input by melting.

Second, the Court in *Hutchison* stated that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations (also see, *Ex parte Masham*, 2 USPQ2d 1647 [1987]). Particularly, the Court did not consider the preamble phrase "adapted for use in the fabrication of a metal template or the like" to "constitute a limitation in any patentable sense". See *Hutchison*, 154 F.2d at 138, 69 USPQ at 141. Thus, *Hutchison* is merely an example of the general rule that the preamble is not [entitled to patentable weight]. In contrast, in the present claim, the phrase "adapted to" is in the body of the claim rather than the preamble, and modifies an element of the claim rather than referring to the entire apparatus. For both of these reasons *Hutchison* is inapplicable.

Third, caselaw has found that "adapted to" clauses in the body of the claims further limits the claimed subject matter and should not be disregarded. For example, in *In re Venezia*, 530 F.2d 956, 958-59, 189 USPQ149, 151-52 (CCPA 1976), the clauses "adapted to be affixed" and "adapted to be positioned" were found to impart structural limitation.

For the above reasons, Applicant respectfully submits that the Examiner's reliance on *In re Hutchison* is misplaced, and requests that the rejection of claims 22 and 35 be withdrawn.

IV. **All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable**

Under Federal Circuit guidelines, a dependent claim is neither anticipated nor rendered obvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplicatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 22 and 35 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

V. **Conclusion**

By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

For all of the reasons set forth above, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Applicant : Pierre-Marc Allemand
Serial No. : 10/606,726
Filed : June 26, 2003
Page : 10 of 10

Attorney's Docket No.: 12406-167001 / P2003,0423 US
E1

including extension of time fees, to Deposit Account 06-1050 and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: _____

11/20/06



Alex Chan

Reg. No. 52,713

Fish & Richardson P.C.
500 Arguello Street, Suite 500
Redwood City, California 94063
Telephone: (650) 839-5070
Facsimile: (650) 839-5071